A

## SKB SHUTTERS MANUFACTURING SDN BHD v. SENG KONG SHUTTER INDUSTRIES SDN BHD & ANOR

FEDERAL COURT, PUTRAJAYA
ZULKEFLI AHMAD MAKINUDIN CJ (MALAYA)
ABDULL HAMID EMBONG FCJ
B JEFFREY TAN FCJ
MOHAMED APANDI ALI FCJ
ABU SAMAH NORDIN FCJ
[CIVIL APPEAL NO: 02(f)-97-12-2014]
26 OCTOBER 2015

C

***INTELLECTUAL PROPERTY:*** *Patent – Infringement – Validity of patent – Whether lacked novelty and inventive step – Patent comprised of multiple claims – Whether court required to assess claim dependent from independent claims before invalidating patent – Whether product was embodiment of patent claims – Whether*
D *claims should be compared with prior art in finding patent invalid – Whether claims could be construed without assistance of skilled persons*

The appellant, the registered proprietor of Patent 431 entitled 'Rolling Door', was in the business of manufacturing, distributing and dealing in roller shutters and roller doors. The appellant's patent pertained to the
E features and parts of a 'rolling door'. The first respondent was also in the business of dealing in roller shutters and related parts. The appellant's claim against the respondents was, *inter alia*, for infringement of the appellant's patent. The respondents' essential defence was that the appellant's patent was invalid by reason that it lacked novelty and an inventive step by reason of
F the prior disclosure and or prior use of the following prior art *ie* an aluminium PVC piece ('the PVC piece') which PVC piece had been sold in the market since 1996, which date was prior to the application date of the appellant's patent. The High Court Judge held that Patent 431 was novel, did not lack an inventive step and was valid and allowed the appellant's claim
G against the respondents. The Court of Appeal reversed the decision of the High Court and held that the High Court Judge had erred when he made a comparison of the appellant's product with the prior art when considering the question of novelty and found that the appellant's patent was obvious to a skilled but unimaginative addressee in the art and lacked an inventive step.
H The Court of Appeal held that the Patent 431 was invalid and that the appellant's claim against the respondents for infringement of the appellant's patent was therefore unsustainable. The appellant thus appealed against the Court of Appeal's decision.

I

The questions of law upon which leave was obtained was (i) where a patent comprises multiple claims, whether, in invalidating a patent for lacking novelty and/or inventive step, the court must take a determination on each and every claim; (ii) where a patent comprises multiples claims, some which were independent, and other claims which were dependent on the independent claims (a) whether having determined that an independent claim of a patent lacked novelty and/or inventive step, the court was required to assess the claim dependent from the said independent claims before invalidating a patent; and (b) whether having only determined that one or more claims of a patent lack novelty and/or inventive step, the court should invalidate those claims whilst preserving the patent in respect of the valid dependent claims; (iii) where there was no dispute that the appellant's product was an embodiment of the claims of the appellant's patent, whether, in assessing prior art to determine if the appellant's patent was anticipated by or was inventive over the prior art, it was permissible to compare features of the appellant's product to the features of the prior art; (iv) whether a comparison between a device that was disclosed by the claims of a patent with a device that was disclosed by an earlier publication (or prior art) was permitted; (v) whether it was open to the Court of Appeal to construe the patent claims without the assistance of persons skilled in the art; (vi) whether it was permissible for the court to refer to the evidence of such experts to make a finding that the concept embodied in the appellant's patent was common general knowledge in the field of mechanical engineering which would be obvious to a normally skilled but unimaginative addressee in the art; and (vii) where there was a finding that the prior art did not contain clear and unmistakable directions to do what the inventor claims to have invented and where the prior art in itself did not disclose the device disclosed by the patent claims, whether it was permissible for the Court of Appeal to make a finding that the appellant's patent lacked novelty as it was anticipated by the prior art.

**Held (dismissing appeal with costs)**
**Per Zulkefli Ahmad Makinudin CJ (Malaya) delivering the judgment of the court:**

**(1)** The claims define the invention in terms of the technical features of the invention. The function of the claims is to define clearly and with precision the monopoly claimed so that others may know the exact boundaries of the area within which they will trespass. It is noted that claims (1) and (11) of the appellant's Patent 431 were independent claims while claims (2) to (10) were dependent claims, being dependent on the preceding claims. All were ultimately dependent on claim (1). As regards the rest of the claims which were dependent claims (claims (2) to (10)), that having considered claim (11) and claim (1) and found them

to be invalid, the Court of Appeal was entitled to then hold that the appellant's Patent 431 was invalid as the rest of the claims, being claims dependent on claim (1), would also fail. (paras 19, 24-26)

**(2)** The dependent claims in essence incorporate all the features of the claim upon which it depended on but were drafted to only make reference to the claim upon which it depended on without expressly setting out all the features of that claim. In the event that the independent claim upon which they depended on was invalid, the only way the dependent claim could survive and stand if at all was if the dependent claims were redrafted to incorporate the features of the claim upon which they were dependent and were made an independent claim. They could not remain as 'dependent claims' when the claim upon which they depended on was invalid. Further, each of the 11 claims lacked an inventive step. Thus, questions (i) and (ii) , if answered, had no impact on independent claims (1) and (11). The questions were academic, in so far as the independent claims were concerned. (paras 27, 30 & 31)

**(3)** The device disclosed by the claims was not identical to the appellant's product. The appellant's product was in three parts but the claims of the appellant's patent did not restrict the device to three parts. There was no concession by the respondents that the claims disclosed a three part product. As the appellant's product differed from the device as disclosed by the claims in the appellant's patent, questions (iii) and (iv) were in fact abstract and hypothetical, not relevant to the facts of this case and did not assist the appellant. The Court of Appeal was correct to construe the claims and compare the claims with the prior art in finding that the appellant's patent was invalid. (paras 35 & 36)

**(4)** The court can construe patent claims without the assistance of a person skilled in the art. Any assistance required is from an expert and he need not approximate a skilled person. The Court of Appeal was entitled to construe the claims of the appellant's patent and compare them with the prior art. Any assistance required on the technology, technical terms and common knowledge had been led through the evidence of DW3, the respondents' expert at trial, whose evidence was before the Court of Appeal. The Court of Appeal was entitled to hold that neither DW3 nor PW1 (the appellant's expert) were 'unimaginative skilled addressees' and yet make reference to their evidence on technical terms and common general knowledge when assessing if the claims of a patent were obvious. (paras 38, 39 & 41)

**(5)** For a patent to lack novelty, it must be shown that the claimed invention had been anticipated in a single document and/or a single prior art. The Court of Appeal had held that the PVC piece did not contain clear and

unmistakable directions to do what the inventor claimed to have invented. It was in the context that there were no literal written 'directions' disclosed by the PVC piece as the PVC piece was a device as opposed to a written publication. However, this did not equate to the Court of Appeal having found by that statement that the PVC piece did not destroy the novelty of the claims of the appellant's patent. Having considered claim (1), the Court of Appeal made a specific finding that all the elements found in the claim were found in the PVC piece and thus the claim was invalid. Question (vii) did not assist the appellant in its case against the respondents. (paras 44 & 45)

***Bahasa Malaysia*** *Translation Of Headnotes*

Perayu, tuan punya berdaftar Paten 431 iaitu 'Rolling Door' menjalankan perniagaan pembuatan, pengedaran dan berurusan dalam bidai *roller* dan pintu *roller*. Paten perayu berkaitan dengan ciri-ciri dan bahagian-bahagian 'rolling door'. Responden pertama juga menjalankan perniagaan berurusan dengan bidai *roller* dan bahagian-bahagian yang berkaitan. Tuntutan perayu terhadap responden-responden, antara lain, adalah bagi pelanggaran paten perayu. Asas pembelaan responden adalah bahawa paten perayu tidak sah kerana tidak baharu dan kurang daya ciptaan atas sebab pendedahan sebelum atau penggunaan terlebih dahulu seni cipta terdahulu iaitu sebuah bahan PVC yang diperbuat daripada aluminium ('bahan PVC') yang telah dijual di pasaran sejak tahun 1996, iaitu sebelum tarikh permohonan paten perayu. Hakim Mahkamah Tinggi telah memutuskan bahawa Paten 431 adalah terbaharu, mempunyai daya cipta dan sah dan telah membenarkan tuntutan perayu terhadap responden-responden. Mahkamah Rayuan membatalkan keputusan Mahkamah Tinggi dan memutuskan bahawa Hakim Mahkamah Tinggi telah terkhilaf apabila membuat perbandingan produk perayu dengan seni terdahulu dalam mempertimbangkan persoalan kebaharuan dan mendapati bahawa paten perayu adalah jelas kepada penerima mahir tetapi tidak imaginitif dalam bidang dan kurang daya cipta. Mahkamah Rayuan memutuskan bahawa Paten 431 tidak sah dan tuntutan perayu terhadap responden-responden untuk pelanggaran paten perayu tidak boleh dipertahankan. Oleh itu, perayu-perayu merayu terhadap keputusan Mahkamah Rayuan. Persoalan undang-undang di mana kebenaran telah diperolehi adalah (i) di mana paten terdiri daripada tuntutan berganda, sama ada, dalam membatalkan paten kerana tidak baharu dan/atau kurang daya cipta, mahkamah harus membuat penentuan bagi setiap satu tuntutan; (ii) di mana paten terdiri daripada tuntutan berganda, yang sebahagiannya mandiri, dan yang lain bergantung kepada tuntutan mandiri (a) sama ada apabila

menentukan tuntutan mandiri paten kekurangan kebaharuan dan/atau langkah daya cipta, mahkamah perlu menilai tuntutan berdasarkan tuntutan mandiri sebelum membatalkan paten; dan (b) sama ada dengan hanya menentukan satu atau lebih tuntutan paten yang tidak baharu dan/atau kurang daya cipta, mahkamah harus membatalkan tuntutan-tuntutan itu di samping mengekalkan paten berkenaan dengan tuntutan bergantung yang sah; (iii) di mana tiada pertikaian bahawa produk perayu adalah kandungan tuntutan paten perayu, sama ada, dalam menilai seni terdahulu untuk menentukan jika paten perayu adalah dijangka oleh atau berdaya cipta atas seni terdahulu, adalah dibenarkan untuk membandingkan ciri-ciri produk perayu dengan ciri-ciri seni terdahulu; (iv) sama ada perbandingan antara peranti yang didedahkan melalui penerbitan yang lebih awal (atau seni terdahulu) dibenarkan; (v) sama ada terbuka kepada Mahkamah Rayuan untuk mentafsirkan tuntutan paten tanpa bantuan orang yang mahir dalam bidang seni; (vi) sama ada mahkamah dibenarkan merujuk kepada keterangan pakar-pakar untuk membuat dapatan bahawa konsep yang terkandung dalam paten perayu adalah pengetahuan am dalam bidang kejuruteraan mekanikal yang akan menjadi jelas kepada penerima yang mempunyai kemahiran yang biasa tetapi tidak mempunyai imaginasi dalam bidang; dan (vii) di mana terdapat dapatan bahawa seni terdahulu tidak mengandungi arahan yang jelas dan terang untuk melakukan apa yang pencipta mendakwa telah mereka cipta dan di mana seni terdahulu tidak mendedahkan peranti yang telah didedahkan oleh tuntutan paten, sama ada Mahkamah Rayuan dibenarkan untuk membuat dapatan bahawa paten perayu tidak baharu kerana ia telah dijangkakan oleh seni terdahulu.

**Diputuskan (menolak rayuan dengan kos)**

**Oleh Zulkefli Ahmad Makinudin HB (Malaya) menyampaikan penghakiman mahkamah:**

**(1)** Tuntutan menentukan ciptaan dari segi ciri-ciri teknikal ciptaan. Fungsi tuntutan adalah untuk menentukan dengan jelas dan dengan tepat monopoli yang dituntut supaya orang lain tahu secara tepat sempadan yang akan mereka ceroboh. Dinyatakan bahawa tuntutan (1) dan (11) Paten 431 perayu adalah tuntutan mandiri manakala tuntutan (2) ke (10) adalah tuntutan bergantung, yang bergantung kepada tuntutan sebelumnya. Semuanya bergantung kepada tuntutan (1). Berkenaan tuntutan-tuntutan lain iaitu tuntutan bergantung (tuntutan (2) ke (10)), selepas mempertimbangkan tuntutan (11) dan tuntutan (1) dan memutuskan bahawa ia tidak sah, Mahkamah Rayuan berhak untuk memutuskan bahawa Paten 431 perayu adalah tidak sah seperti tuntutan-tuntutan yang lain, kerana tuntutan yang bergantung pada tuntutan (1), akan gagal.

**(2)** Tuntutan-tuntutan bergantung, pada asasnya, gabungan semua ciri-ciri tuntutan di mana ia bergantung kepada tetapi digubal untuk hanya membuat rujukan kepada tuntutan di mana ia bergantung tanpa menyatakan dengan jelas segala ciri-ciri tuntutan. Dalam keadaan tuntutan mandiri yang bergantung pada tuntutan-tuntutan lain adalah tidak sah, satu-satunya cara tuntutan bergantung boleh dipertahankan dan berdiri adalah jika tuntutan bergantung digubalkan semula untuk menggabungkan ciri-ciri tuntutan di mana mereka bergantung kepada dan dibuat sebagai tuntutan mandiri. Tuntutan-tuntutan itu tidak boleh kekal sebagai 'tuntutan bergantung' apabila tuntutan yang mereka bergantung kepada adalah tidak sah. Oleh itu, setiap satu daripada 11 tuntutan tidak mempunyai langkah daya cipta. Oleh itu, soalan (i) dan (ii), jika dijawab, tidak mempunyai kesan ke atas tuntutan mandiri (1) dan (11). Soalan bersifat akademik, setakat tuntutan mandiri berkenaan.

**(3)** Peranti yang didedahkan oleh tuntutan tidak sama dengan produk perayu. Produk perayu mempunyai tiga bahagian tetapi tuntutan paten perayu tidak menyekat peranti ke tiga bahagian. Tiada konsesi oleh responden bahawa tuntutan mendedahkan produk tiga bahagian. Oleh kerana produk perayu berbeza daripada peranti seperti yang didedahkan oleh tuntutan-tuntutan dalam paten perayu, soalan (iii) dan (iv) sebenarnya adalah abstrak dan andaian, dan tidak relevan kepada fakta kes ini dan tidak membantu perayu. Mahkamah Rayuan betul dalam mentafsirkan tuntutan dan membandingkan tuntutan dengan seni terdahulu dalam mendapati bahawa paten perayu adalah tidak sah.

**(4)** Mahkamah boleh mentafsir tuntutan paten tanpa bantuan seseorang yang mahir dalam bidang. Apa-apa bantuan yang diperlukan adalah oleh seorang pakar dan dia tidak perlu seseorang yang mahir. Mahkamah Rayuan berhak untuk mentafsirkan tuntutan paten perayu dan membandingkannya dengan seni terdahulu. Apa-apa bantuan yang diperlukan berkenaan teknologi, dari segi teknikal dan pengetahuan umum telah dibawa melalui keterangan PW3, pakar untuk pihak responden semasa perbicaraan, yang keterangannya dikemukakan di hadapan Mahkamah Rayuan. Mahkamah Rayuan berhak memutuskan bahawa DW3 dan PW1 (pakar untuk pihak perayu) bukan penerima mahir tidak imaginitif tetapi merujuk kepada keterangan mereka berkenaan istilah teknikal dan pengetahuan am biasa apabila menilai sama ada tuntutan paten adalah jelas.

**(5)** Untuk paten tidak baharu harus dibuktikan bahawa reka cipta yang dituntut telah dijangkakan dalam satu dokumen dan/atau satu seni terdahulu. Mahkamah Rayuan telah memutuskan bahawa bahan PVC tidak mengandungi arahan yang jelas dan terang untuk melakukan apa yang pencipta dakwa telah diciptanya. Adalah dalam konteks bahawa

tiada 'arahan' bertulis yang harfiah didedahkan oleh bahan PVC kerana bahan PVC adalah peranti berbanding dengan sebuah penerbitan bertulis. Walau bagaimanapun, ini tidak bermakna Mahkamah Rayuan mendapati bahawa dengan kenyataan itu bahan PVC tidak memansuhkan kebaharuan tuntutan paten perayu. Setelah menimbangkan tuntutan (1), Mahkamah Rayuan membuat dapatan spesifik bahawa segala elemen-elemen yang didapati dalam tuntutan didapati dalam bahan PVC dan oleh itu, tuntutan tidak sah. Soalan (vii) tidak membantu perayu dalam kes ini terhadap responden-responden.

**Case(s) referred to:**

*E I Du Pont De Nemours & Co v. Imperial Chemical Industries Plc & Anor (2007) FCAFC 163* ***(refd)***

*Electric and Musical Industries Ld & Ors v. Lissen Ld & Anor (1939) RPC 23* ***(refd)***

*Technip France SA's Patent (2004) RPC 46* ***(refd)***

*The General Tire & Rubber Co v. The Firestone Tyre & Rubber Co Ltd & Ors [1972] RPC 457* ***(refd)***

*Windsurfing International Inc v. Tabur Marine (Great Britain) Ltd [1985] RPC 59* ***(refd)***

**Legislation referred to:**

Courts of Judicature Act 1964, s. 78

Patents Act 1983, ss. 11, 12, 13(1), 14, 15, 16, 31(1), 36(3), 56(2), (3), 58

Patents Regulations 1986, regs. 13(5), 14

Patents Act 1977 [UK], ss. 63(1), 75

*For the appellant - Khoo Guan Huat (Kuek Pei Yee, Sri Richgopinath & Melissa Long with him); M/s Skrine*

*For the respondents - Ambiga Sreenevasa (Janini Rajeswaran, Quah Su Enn, Adeline Yew & Gerald Samuel with her); M/s Ranjit Singh & Yeoh*

*Reported by Suhainah Wahiduddin*

## JUDGMENT

**Zulkefli Ahmad Makinudin CJ (Malaya):**

### Introduction

**[1]** This is the appellant's/plaintiff's appeal against the whole of the decision of the Court of Appeal in allowing the respondents'/defendants' appeal against the decision of the High Court of Kuala Lumpur. It was the finding of the Court of Appeal that the appellant's Malaysian Patent No. My-128431-A ("Patent 431") was invalid and that the appellant's claim against the respondents for infringement of the appellant's patent was therefore unsustainable. In consequence thereof, the Court of Appeal reversed the decision of the High Court in allowing the claim against the respondents for infringement of the appellant's patent.

**[2]** The questions of law upon which leave as obtained read as follows: A

(1) Where a patent comprises multiple claims, whether, in invalidating a patent for lacking novelty and/or inventive step, the Court must make a determination on each and every claim.

(2) Where a patent comprises multiple claims, some of which are independent, and other claims which are dependent on the independent claims: B

(i) whether having determined that an independent claim of a patent lacks novelty and/or inventive step, the Court is required to assess the claim dependent from the said independent claims before invalidating a patent; and C

(ii) whether having only determined that one or more claims of a patent lack novelty and/or inventive step, the Court should invalidate those claims whilst preserving the patent in respect of the valid dependent claims.

(3) Where there is no dispute that the appellant's /plaintiff's product is an embodiment of the claims of the appellant's patent, whether, in assessing Prior Art to determine if the appellant's patent is anticipated by or is inventive over the Prior Art, it is permissible to compare features of the appellant's product to the features of the Prior Art. D E

(4) Whether, on a true construction of the case of *The General Tire & Rubber Co. v. The Firestone Tyre & Rubber Co. Ltd. & Ors.* [1972] RPC 457, in particular the passage of Sachs LJ that was cited by the Court of Appeal, when the English Court of Appeal referred to "... To determine whether a patentee's claim has been anticipated by an earlier publication it is necessary to compare the earlier publication with the patentee's claim ... If the earlier publication so construed discloses the same device as the device which the patentee by his claim, so construed, asserts that he has invented, the patentee's claim has been anticipated, but not otherwise. In such circumstances the patentee is not the true and first inventor of the device and his claimed invention is not new ...", a comparison between a device that is disclosed by the claims of a patent with a device that is disclosed by an earlier publication (or Prior Art) is permitted. F G

(5) In the event the answer to Questions 3 and 4 above are in the negative, whether, having determined that the Prior Art must be compared to the Patent Claims in assessing if the appellant's patent is anticipated by or is inventive over the Prior Art, it is open to the Court of Appeal to construe the Patent Claims without the assistance of persons skilled in the art. H

(6) Upon finding that the expert witnesses could hardly be described as "the unimaginative skilled addressee" in determining if there is inventive step in the appellant's invention or otherwise, whether it I

A is permissible for the Court to refer to the evidence of such experts to make a finding that the concept embodied in the appellant's patent is common general knowledge in the field of mechanical engineering which would be obvious to a normally skilled but unimaginative addressee in the art.

B (7) Where there is a finding that the Prior Art does not contain clear and unmistakeable directions to do what the inventor claims to have invented and where the Prior Art in itself does not disclose the device disclosed by the Patent Claims, whether it is permissible for the Court of Appeal to make a finding that the appellant's patent lacks novelty as it is anticipated by the Prior Art.

C **Background Facts**

**[3]** The appellant is the registered proprietor of Patent 431 entitled "Rolling Door". The appellant's patent pertain to the features and parts of a "rolling door". The appellant is in the business of manufacturing, D distributing and dealing in roller shutters, roller doors and a wide range of shutters.

**[4]** The first respondent is also in the business of dealing in roller shutters and related parts. The second respondent who is a director of the first respondent was sued in his personal capacity as the sole proprietor of Sing E Keong Enterprise which ceased business sometime in or about 2008.

**[5]** The appellant's claim against the respondents was *inter alia* for infringement of the appellant's patent. The appellant alleged that the respondents by manufacturing, selling, offering for sale and using roller shutters which incorporate the features of the appellant's patent, had F infringed the appellant's patent.

**[6]** The respondents' essential defence was that the appellant's patent was invalid by reason that it lacked novelty and an inventive step by reason of the prior disclosure and or prior use of the following prior art:

G (a) An aluminium PVC piece ("the PVC piece") which PVC piece had been sold in the market since 1996, which date is prior to the application date of the appellant's patent on 24 February 1997.

(b) United States Patent No. 5456305 ("US'305 Patent") for "Rollable or Foldable Shutter" filed on 18 January 1995 and published prior to H 24 February 1997.

(c) United States Patent No. 4433714 ("US'714 Patent") for "Roller Shutter Doors" filed on 23 October 1981 and published prior to 24 February 1997.

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**Findings Of The High Court**

**[7]** The learned High Court Judge held that Patent 431 was novel, did not lack an inventive step and was valid and allowed the appellant's claim against the respondents for infringement of the appellant's patent. In considering the question of novelty of the appellant's patent the learned High Court Judge made a comparison of the appellant's product with the prior art.

**Findings Of The Court Of Appeal**

**[8]** The Court of Appeal reversed the decision of the High Court and held that the learned High Court Judge erred when he made a comparison of the appellant's product with the prior art when considering the question of novelty of the appellant's patent when he should have compared the claims of the appellant's patent with the prior art. The Court of Appeal made comparison between the features of claim (1) of the appellant with the PVC piece and found that the said claim was not novel and had been anticipated by the PVC piece.

**[9]** The Court of Appeal in arriving at its decision that the appellant's patent lacked an inventive step adopted the approach in *Windsurfing International Inc. v. Tabur Marine (Great Britain) Ltd* [1985] RPC 59 and found that the appellant's patent was obvious to a skilled but unimaginative addressee in the art and lacked an inventive step.

**Principles Of Patent Law**

**[10]** At the outset it would be appropriate here to state the relevant provisions of the law and the principles relating to patent. In Malaysia patent is a creature of statute and as a general rule the rights and protection thereof are found within the Patents Act 1983 ("the Act") and the Patents Regulations 1986 ("the Regulations").

**[11]** On "Invention" s. 12 of the Act states that:

> (1) An invention means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology.
>
> (2) An invention may be or may relate to a product or process.

**[12]** On "Patentable Invention" s. 11 of the Act states that:

> An invention is patentable if it is new, involves an inventive step and is industrially applicable.

In order for an invention to be granted a monopoly and protected under the Act, it must be new, involves an inventive step and be industrially applicable.

**[13]** On the meaning of "Novelty" or "New" s. 14 of the Act defines what is new as follows:

> (1) An invention is new if it is not anticipated by prior art.
>
> (2) Prior art shall consists of:
>
> (a) everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the patent application claiming the invention.
>
> …

**[14]** An "Inventive step" is defined in s. 15 of the Act as follows:

> An invention shall be considered as involving an inventive step if, having regard to any matter which forms part of the prior art under paragraphs 14(2)(a), such inventive step would not have been obvious to a person having ordinary skill in the art.

**Rights Of Patent Owner**

**[15]** The owner of a patent shall have the exclusive right to *inter alia* exploit the patented invention. "Exploitation" is defined in the Act to include, when the patent is granted in respect of a product, the "making, importing, offering for sale, selling or using the product and stocking such product for the purpose of offering for sale, selling and using". (See s. 36 of the Act).

**Infringement**

**[16]** Infringement is the performance of any acts referred to in s. 36(3) of the Act in Malaysia by a person other than the owner of the patent and without the agreement of the latter in relation to a product or a process falling within the scope or protection of the patent. (See s. 58 of the Act).

**Invalidation Of A Patent**

**[17]** The court may invalidate a patent if *inter alia* that what is claimed as an invention in the patent is not an invention within the meaning of s. 12 or is excluded from protection under s. 13 or sub-s. 31(1) or is not patentable because it does not comply with the requirements of ss. 11, 14, 15 and 16. (See s. 56(2) of the Act).

**[18]** The grounds to invalidate a patent thus include (i) if the patent is not new (s. 14) or (ii) lacks an inventive step (s. 15). Section 56(3) of the Act states that where it applies only to some claims or parts of a claim, such claims or parts of a claim may be declared invalid by the court and the invalidity of part of a claim shall be declared in the form of a corresponding limitation of the claim in question.

### Claims

**[19]** The claims define the invention in terms of the technical features of the invention. (See reg. 13(5) of the Regulations). The function of the claims is to define clearly and with precision the monopoly claimed so that others may know the exact boundaries of the area within which they will trespass. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed. (See Terrell on the *Law of Patents*).

**[20]** The first claim is usually the main claim which is made as wide as possible. The subsidiary claims refer to the main claim and include qualifying or explanatory clauses on the various integers of the main claim or optional features. They may also contain independent claims.

### Dependent Claims

**[21]** Claims which include all the features of one or more of the other claims are known as dependent claims. They will, if possible at the beginning, contain a reference to the other claim or claims and will then state the additional features claimed. (See reg. 14 of the Regulations). A claim which is not dependent on another is known as an independent claim.

### Decision

*Questions (1) And (2)*

**[22]** We shall first deal with questions (1) and (2) together. Learned counsel for the appellant submitted that the Court of Appeal's findings of invalidation are unsound in its entirety, because the invalidation of entire Patent 431 following a finding of only one invalid claim and/or invalid parts of a claim is unsustainable in law. It was contended for the appellant that at most the Court of Appeal could only partially invalidate Patent 431.

**[23]** The appellant also contended that the Court of Appeal failed to assess each claim individually for lack of novelty and or an inventive step. As such, it was argued that those claims which had not been assessed individually ought not to have been declared invalid by the Court of Appeal.

**[24]** It is noted that claims (1) and (11) of the appellant's Patent 431 are independent claims. Claims (2) to (10) of the appellant are dependent claims, being dependent on the preceding claims. All are ultimately dependent on claim (1).

**[25]** On the issue of novelty, it is clear that the Court of Appeal considered claim (1). We are of the view that the Court of Appeal also considered claim (11). In fact the appellant's witness PW2 conceded that "the US'305 Patent is probably destructive of the novelty of claim (11)".

**[26]** As regards the rest of the claims which are dependent claims (claims (2) to (10)), we are of the view that having considered claim (11) and claim (1) and found them to be invalid, the Court of Appeal was entitled to then hold that the appellant's Patent 431 was invalid as the rest of the claims, being claims dependent on claim (1), would also fall.

**[27]** The dependent claims in essence incorporate all the features of the claim upon which it depends but are drafted to only make reference to the claim upon which it depends without expressly setting out all the features of that claim. As such, in the event that the independent claim upon which they depend is invalid, the only way the dependent claims can survive and stand if at all is if the dependent claims are redrafted to incorporate the features of the claim upon which they are dependent and are made an independent claim. They cannot remain as "dependent claims" when the claim upon which they depended is invalid. We agree with the contention of the respondents as that was not done in the present case and as it could not be redrafted, the dependent claims must fall. (See the case of *E I Du Pont De Nemours & Co v. Imperial Chemical Industries Plc & Anor* (2007) FCAFC 163].

**[28]** The position in Malaysia relating to amendments of patent claims must be distinguished from the position in the United Kingdom. In the United Kingdom, the patent claim can be amended pending litigation in respect of its validity. (See s. 75 of the UK Patents Act 1977). There is a further provision which gives the court in the United Kingdom express power to enforce the part of the patent which is found to be valid. Section 63(1) of the UK Patents Act 1977 states as follows:

> If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the court or the comptroller may, subject to subsection (2) below, grant relief in respect of that part of the patent which is found to be valid and infringed.

**[29]** There is no such provision in the Malaysian Patents Act 1983 similar to the provisions of ss. 63 and 75 of the UK Patents Act 1977. It is clearly by reason of the said provision of s. 63 in the United Kingdom that one can enforce a partially valid patent without amendment. Section 56(3) of our Patents Act 1983 is clearly not the equivalent of s. 63 of the UK Patents Act 1977. It merely states that some claims or part of a claim may be declared invalid which in our view it can only refer to the independent claims of a patent.

**[30]** On the issue of lack of inventive step we agree with the submissions of respondents that each of the 11 claims lacked an inventive step. Although the Court of Appeal did not expressly state that they dealt with each of the said claims, it should be obvious it must have been so dealt with in light of the submission of the respondents and the finding of a lack of inventive step in the appellant's Patent 431 with regard to claims 1 and 11.

**[31]** It is our judgment that questions (1) and (2) if answered can have no impact on independent claims (1) and (11). The questions are academic, in so far as the independent claims are concerned.

*Questions (3) And (4)*

**[32]** We shall now deal with questions (3) and (4) together. Questions 3 and 4 relate to the principles of novelty on a comparison of the prior art to the device embodiment of the patent claims. It was submitted for the appellant that the learned High Court Judge was at liberty to compare the appellant's device on the basis that it constituted the claimed invention in itself and that the principles of *The General Tire & Rubber Co v. The Firestone Tyre & Rubber Co Ltd & Ors (supra)* do not exclude the comparison of a device disclosed by prior use with the device embodiment of a patent and/or patent claim in question.

**[33]** The respondents however submitted that when assessing the issue of novelty and inventive step, the High Court ought to have compared the claims of the appellant's patent and not the appellant's product with the prior art. On this point the case of *The General Tire & Rubber Co v. The Firestone Tyre & Rubber Co Ltd & Ors (supra)* held as follows:

> To determine whether a patentee's claim has been anticipated by an earlier publication it is necessary to compare the earlier publication with the patentee's claim.

**[34]** We are of the view the law is clear that when it has to determine if an invention which is the subject of a patent claim lacks novelty or inventive step, one looks at the language of the claims which define the scope and monopoly claimed. (See the case of *Electric and Musical Industries Ld & Ors v. Lissen Ld & Anor* (1939) RPC 23). The reference in *The General Tire & Rubber Co v. The Firestone Tyre & Rubber Co Ltd & Ors (supra)* to a device is still in the context of a device as disclosed by the claims. It is ultimately the claims which must be looked at and considered.

**[35]** We find on the facts of this case that the device disclosed by the claims is not identical to the appellant's product. The appellant's product is in three parts but the claims of the appellant's patent do not restrict the device to three parts. There was no concession by the respondents that the claims disclosed a three part product.

**[36]** As the appellant's product differs from the device as disclosed by the claims in the appellant's patent, questions (3) and (4) are in fact abstract and hypothetical, not relevant to the facts of this case and do not assist the appellant. We agree with the contention of the respondents that the Court of Appeal was correct to construe the claims and compare the claims with the prior art in finding that the appellant's patent was invalid.

*Questions (5) and (6)*

**[37]** We shall deal with questions (5) and (6) together. These two questions relate to the issue of whether there are requirements for patent construction and assessment by persons skilled in the art. It was submitted for the appellant that the Court of Appeal wrongly invalidated Patent 431 as it did so without the assistance of appropriate technical experts and/or without the sufficient backing of the technical evidence from persons skilled in the relevant art particularly on:

(i) the technical meaning and wording of the claims in light of the relevant art;

(ii) the common general knowledge;

(iii) the inventive concept of each claim in question;

(iv) the differences between the inventive concept and the state of the art; and

(v) whether it is obvious.

**[38]** On the said questions (5) and (6) posed by the appellant we are of the view the general principles relating to the construction of patent claims and the role to be played by the "experts" are well established. The function of the expert is to educate the court in technology and that they come as teachers, as makers of the mantle for the court to don. For that purpose it does not matter if they do not approximate a person skilled in the art. (See the case of *Technip France SA's Patent* (2004) RPC 46). As such, clearly the court can construe patent claims without the assistance of a person skilled in the art. Any assistance required is from an expert and he need not approximate a skilled person.

**[39]** It is our judgment that the Court of Appeal was entitled to construe the claims of the appellant's patent and compare them with the prior art. Any assistance required on the technology, technical terms and common general knowledge had been led through the evidence of DW3, the respondents' expert at trial, whose evidence was before the Court of Appeal.

**[40]** As regards claims (4) to (11), a perusal of the same evinces that any additional features relate to simple concepts, are unambiguous and plain in meaning and in respect of which in our view required no explanation on the technical terms.

**[41]** We are of the considered view that as the experts who educate the court on technology, technical terms and common general knowledge do not have to approximate persons skilled in the art, the Court of Appeal was entitled to hold that neither DW3 (the respondents' experts) nor PW1 (the

appellant's expert) were "unimaginative skilled addressees" and yet make reference to their evidence on technical terms and common general knowledge when assessing if the claims of a patent were obvious.

*Question (7)*

**[42]** Question (7) touches on principle of assessment of novelty. It was submitted for the appellant that the Court of Appeal's assessment of novelty on Patent 431 when compared to the PVC piece prior art was flawed in holding that the PVC piece did not contain clear and unmistakable directions to do what the inventor claims to have invented.

**[43]** It was also contended for the appellant that the Court of Appeal had wrongly considered the "diagrams" and "drawings" in addition to the PVC piece in this part as they:

(i) did not form part of the prior art;

(ii) were not led in evidence by either parties' experts; and

(iii) which were not adduced at trial but only on appeal.

We are of the view the "diagrams" and the "drawings" submitted before the Court of Appeal were merely to assist the Court of Appeal in its assessment of novelty of claims 1 and 11 which contained drawings of the PVC piece already admitted in evidence as well as drawings of the appellant's patent which were from the patent itself and also already admitted in evidence. They were submitted to illustrate the features found in the claims and in the PVC piece for comparison. The diagrams and drawings were not a separate prior art.

**[44]** For a patent to lack novelty, it must be shown that the claimed invention has been anticipated in a single document and/or a single prior art. We are of the view the Court of Appeal's reference to the fact that the PVC piece did not contain clear and unmistakable directions must be read in context. It is clear that the Court of Appeal held that the PVC piece did not contain clear and unmistakable directions to do what the inventor claimed to have invented. It was in the context that there were no literal written "directions" disclosed by the PVC piece as the PVC piece was a device as opposed to a written publication. However, this does not equate to the Court of Appeal having found by that statement that the PVC piece did not destroy the novelty of the claims of the appellant's patent.

**[45]** Having considered claim (1), the Court of Appeal made a specific finding that all the elements found in the claim were found in the PVC piece and thus the claim was invalid. Question (7) assumes the fact that the claims did not disclose the device disclosed by the prior art when this is inaccurate as a finding of fact had been made that it did. We are therefore of the view question (7) does not assist the appellant in its case against the respondents.

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## Conclusion

**[46]** For the reasons abovestated, we the remaining judges (see s. 78 of the Courts of Judicature Act 1964) following the resignation of Mohamed Apandi Ali FCJ, as he then was, now Attorney General, find there is no merit in this appeal. The appeal is therefore dismissed with costs.

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